REMARKS

I. Introduction

Claims 1-56 were pending in this case. Applicants have cancelled claims 20-36 and 49-56 without prejudice. This cancellation is expressly without waiver of applicants' right to pursue the subject matter of the cancelled claims in one or more continuation applications.

Claims 1-56 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over either claims 1-59 of Brenner et al., U.S. Patent No. 6,004,211 (hereinafter "Brenner '211") or claims 1-132 of Brenner et al., U.S. Patent No. 5,830,068 (hereinafter "Brenner '068"), each in view of Lawler et al., U.S. Patent No. 5,805,763 (hereinafter "Lawler").

The Examiner's rejections are respectfully traversed.

II. Applicants' Reply to the Double Patenting Rejections

All of the rejections set forth in the Examiner's March 21, 2002 Office Action are under the judicially-created doctrine of obviousness-type double patenting (analogous to a failure to meet the non-obviousness requirements of 35 U.S.C. § 103 according to MPEP § 804(II)(B)(1)) and are based on combining either the claims of Brenner '211 or the claims of Brenner '068 with Lawler. However, applicants respectfully submit that both of the Examiner's rejections fail for the following independent reasons.

1. The Examiner Has Failed To Consider Applicants' Claims As A Whole

On pages 2-6 of the Office Action, the Examiner separately lists individual elements of applicants' claimed invention and considers the patentability of each isolated element rather than the patentability of each claim as a whole. The Examiner reaches a conclusion of obviousness based on this cumulative and piecemeal consideration of each isolated element and not based on the context of the claim as a whole. However, it is well established that a conclusion of obviousness must be based upon the subject matter of a claim as a whole and that "claim language cannot be considered in isolation but, rather, must be interpreted in the context of the claim as a whole." Ex parte Powell et al., Bd. Pat. App. & Inter. 1997, 9, (unpublished); Ex parte Phan et al., Bd. Pat. App. & Inter. 1997, 11 (unpublished). See also 35 U.S.C. § 103(a).

Accordingly, because the Examiner considers each element of applicants' claimed invention in isolation and not in the context of the claim as a whole, applicants submit that the Examiner's rejections are improper and should be withdrawn.

2. The Examiner Has Not Provided The Requisite Motivation For Combining the Claims Of Brenner '068 Or The Claims Of Brenner '211 With Lawler

Even if it is determined that the Examiner properly considered applicants' claims as a whole, the obviousness-type rejections must be withdrawn because the Examiner has failed to provide a sufficient motivation for combining the claims of Brenner '068 or Brenner '211 with Lawler. See In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir.

1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.") See also MPEP §§ 2142 and 2143.01. It is well-settled that an Examiner can "satisfy this burden only by showing some objective teaching ... that would lead [one of ordinary skill in the art] to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

Instead of providing an objective teaching of a motivation, however, the Examiner merely concludes that it would have been obvious to combine either the claims of Brenner '068 or the claims of Brenner '211 with Lawler to obtain the benefit of applicants' novel approach:

> In view of Lawler, it would have been obvious to one skilled in the art at the time of the invention to . . . improve Brenner by adding a user interface that automatically provides users the opportunity to record race events while interacting with a wager selection menu in order to provide a quick and easy means of storing broadcast races in a personal archive.

Page 7 of the Office Action. This is tantamount to saying that it would have been obvious to combine either the claims of Brenner '068 or the claims of Brenner '211 with Lawler because it would have lead to applicants' invention. Such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999); see also In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (The factual inquiry of whether to combine references must be thorough and searching); MPEP § 2143.

Without objective evidence of a motivation to combine, the obviousness rejection is the "essence of hindsight" reconstruction, the very "syndrome" that the

requirement for such evidence is designed to combat, and insufficient as a matter of law. In re Dembiczak at 999. For this reason alone the Examiner's obviousness-type double patenting rejection must be withdrawn. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579 (Fed. Cir. 1997).

3. The Combination Of The Claims Of Brenner '211 Or The Claims Of Brenner '068 With Lawler Fails To Show Or Suggest All Elements Of Applicants' Claimed Invention

Even if it is determined that the Examiner properly considered applicants' claims as a whole and that the Examiner properly combined the cited references, applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness because, as set forth in detail below, the combination of either the claims of Brenner '211 or the claims of Brenner '068 with Lawler fails to show or suggest all elements of applicants' claimed invention. See MPEP § 2142. Accordingly, the Examiner's rejections should be withdrawn.

A. Claims 1-18 and 37-47

Applicants' invention, as defined by claims 1 and 37, is directed to a method and system for wagering on and recording races using an interactive wagering application. A user of the wagering application is allowed to create and place a wager for a given race by interacting with a plurality of wager creation options. While the user interacts with the wager creation options, the interactive wagering application automatically provides the user with an option to record the given race. The Background section

of the present application explains that automatically providing users with an option to record a race while interacting with the wager creation options is preferable to other systems that may allow users to indicate a desire to record a race at some other time or procure a recording of a race through some other means.

The Examiner contends, on page 3 of the Office Action, that claims 69, 89, 92, 93, 96, 100 and 125 of Brenner '068 disclose "providing the user with an option to record the given race while the user is interacting with a plurality of wager creation options." Contrary to the Examiner's contention, these claims do not specifically disclose "providing the user with an option to record the given race while the user is interacting with a plurality of wager creation options."

More specifically, claims 69 and 100 of Brenner '068 refer to a system and method for interactively wagering on live races using an off-track wagering system. Claims 69 and 100 of Brenner '068 further refer to distributing racing data and real-time racing videos. However, nowhere in claims 69 and 100 of Brenner '068 is it specifically disclosed to provide the user with an option to record a given race while the user is interacting with a plurality of wager creation options as required by applicants' claims 1 and 37.

Claims 89, 92, and 96 of Brenner '068 refer to displaying racing data or real-time racing videos. However, nowhere in claims 89, 92, and 96 of Brenner '068 is it specifically disclosed to provide the user with an option to record a given race while the user is interacting with a plurality of wager creation options as required by applicants' claims 1 and 37.

Claim 93 of Brenner '068 refers to setting and triggering an alert function when a predetermined race is about to be run and displaying the racing video of the predetermined race. However, nowhere in claim 93 of Brenner '068 is it specifically disclosed to provide the user with an option to record a given race while the user is interacting with a plurality of wager creation options as required by applicants' claims 1 and 37.

Claim 125 of Brenner '068 includes "the step of setting a video recorder to record a predetermined one of said racing videos." This step, however, does not specifically disclose automatically providing the user with an option to record a given race while the user is interacting with a plurality of wager creation options as required by applicants' claims 1 and 37.

The Examiner further contends, on page 3 of the Office Action, that claims 1, 19, 37, 58, and 59 of Brenner '211 disclose "providing the user with an option to record the given race while the user is interacting with a plurality of wager creation options." Contrary to the Examiner's contention, these claims do not specifically disclose "providing the user with an option to record the given race while the user is interacting with a plurality of wager creation options."

Claims 1, 19, 37, and 58 of Brenner '211 include providing "a user with an opportunity to place a wager on a given race that has not been run." This element of claims 1, 19, 37, and 58 of Brenner '211, however, does not specifically disclose providing the user with an option to record a given race while the user is interacting with a plurality of wager creation options as required by applicants' claims 1 and 37.

Claim 59 of Brenner '211 refers to allowing a user to select a desired track and race for placing a wager. However, claim 59 of Brenner '211 does not specifically disclose allowing a user to record a race. Furthermore, claim 59 of Brenner '211 does not specifically disclose providing the user with an option to record a given race while the user is interacting with a plurality of wager creation options as required by applicants' claims 1 and 37. Indeed, Lawler has nothing to do with wagering screens of any kind.

The Examiner contends, on page 5 of the Office Action, that FIGS. 1-9 of Lawler disclose "providing the user with an option to record the given race while the user is interacting with a plurality of wager creation options." Contrary to the Examiner's contention, FIGS. 1-9 of Lawler do not show or suggest allowing users to interact with a plurality of wager creation options. Rather, FIGS. 1-9 of Lawler refer to an interactive program guide system, in which a user may interact with the interactive program guide to record a television program. Nowhere in Lawler is it disclosed or suggested to provide the user with an option to record a given race while the user is interacting with a plurality of wager creation options as required by applicants' claims 1 and 37.

Accordingly, the claims of Brenner '068, the claims of Brenner '211, and Lawler, whether taken alone or in combination, fail to disclose or suggest automatically providing a user with an option to record a given race while the user is interacting with a plurality of wager creation options as required by applicants' claims 1 and 37. Therefore, applicants request that the obviousness-type double patenting rejections of independent

claims 1 and 37, and dependent claims 2-18 and 38-47, be withdrawn.

B. Claims 19 and 48

Applicants' invention, as defined by claims 19 and 48, is directed to a method and system for wagering on and recording races using an interactive wagering application. A user of the wagering application is allowed to create and place a wager for a given race by interacting with a plurality of wager creation options. The interactive wagering application automatically provides the user with an option to record a race in response to a user placing a wager for the race. The Background section of the present application explains that automatically providing users with an option to record a race in response to a user placing a wager for the race is preferable to other systems that may allow users to indicate a desire to record a race at some other time or procure a recording of a race through some other means.

The Examiner contends that the claims of Brenner '068 and Brenner '211 disclose "providing the user with an option to record the given race while the user is interacting with a plurality of wager creation options" in connection with the rejection of claims 19 and 48. The claims of Brenner '068 and Brenner '211 on which the Examiner relies to support this contention are the same claims discussed above in connection with claims 1-18 and 37-47. However, for the reasons discussed above, the claims of Brenner '068 and Brenner '211 fail to disclose or suggest "providing a user with an option to record a given race while the user is interacting with a plurality of wager creation options."

More significantly, claims 19 and 48 do not even refer to this limitation. Instead, as discussed above, claims 19 and 48 specify automatically providing the user with an option to record a race in response to a user placing a wager for the race. However, the Examiner has failed to address this limitation of claims 19 and 48. Applicants submit that the claims of Brenner '068 and Brenner '211 do not disclose or suggest automatically providing the user with an option to record a race in response to a user placing a wager for the race as required by applicants' claims 19 and 48.

The Examiner further fails to provide any evidence that independent claims 19 and 48 are made obvious by Lawler. Lawler, as discussed above, refers to an interactive program guide system and does not disclose or suggest allowing a user to place a wager for a race.

Therefore, the claims of Brenner '068, the claims of Brenner '211, and Lawler, whether taken alone or in combination, fail to disclose or suggest automatically providing the user with an option to record a race in response to a user placing a wager for the race as specified by claim 19 and 48. Accordingly, applicants request that the obviousness-type double patenting rejections of independent claims 19 and 48 be withdrawn.

III. Reply To The Examiner's Response To Arguments

The Examiner states, on page 7 of the Office Action, that "[a]pplicants' arguments filed Jan. 28, 2002 have been fully considered but they are not persuasive. Brenner '068 includes automatic recording. See claims 69, 89." Apparently, the Examiner believes that applicants argued that Brenner '068 does not include automatic

recording. However, applicants did not present this argument in the January 28, 2002 Reply to Office Action. Rather, applicants argued that the claims of Brenner do not show or suggest "automatically providing the user with an option to record a given race while the user is interacting with a plurality of wager creation options as specified by applicants' independent claims 1 and 37" (see page 6 of applicants' January 28, 2002 Reply to Office Action) and the claims of Brenner do not show or suggest "automatically providing the user with an opportunity to record a given race in response to the user placing a wager for the given race as specified by applicants' claims 19 and 48" (see page 7 of applicants' January 28, 2002 Reply to Office Action).

IV. Conclusion

For at least the reasons set forth above, claims 1-19 and 37-48 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,

James A. Leiz
Registration No. 46,109
Agent for Applicants
FISH & NEAVE
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1104
Tel.: (212) 596-9000